

## **Remarks**

Claims 1, 3, 4, 8, 10 and 11 are pending in the application. Applicant thanks the Examiner for noting the allowability of claim 4 upon overcoming the 35 USC §112 rejection of base claim 1, and respectfully traverses with amendment the rejection of the other pending claims 1, 3, 8, 10 and 11.

### **Claim rejections under 35 U.S.C. §112, first paragraph**

Claims 1, 3, 4, 8, 10 and 11 were rejected as failing to comply with the written description requirement. More specifically, the limitation "non-reactive as incorporated in the polysiloxane" was asserted to be new matter and not having any support for the subject matter in the specification.

Claim 1 has been amended to remove the limitation, but Applicant respectfully indicates that the presently claimed invention carries no reactive functional group, which is a basis for distinguishing the present invention from the cited Swei<sup>1</sup> reference. Applicant also respectfully notes that, according to M.P.E.P §2163.02, "the subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." Thus, Applicant's disclosure of the term "non-reactive" in a claim is acceptable even if the exact term was not used in the disclosure, provided adequate support is provided support for non-reactive embodiments are provided (as they are) in the disclosure.

Claims 3, 4, 8, 10 and 11 all depend from claim 1, thus, the objectionable limitation has been stricken from these claims as well. obviating this ground for rejection.

### **Claim rejections under 35 U.S.C. §102/103**

Claims 1, 3, 8, 10 and 11 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103 as obvious over Swei. The Action asserts that while Swei does not disclose the claimed hardness values, it appears that Swei inherently discloses these values because the materials of Swei "are the same as those claimed by Applicant" or "at least

---

<sup>1</sup> U.S. Patent No. 5,182,173 issued January 26, 1993, to Gwo Swei

similar to those as claimed by Applicant," and that Applicant's previous response did not make clear how the silicone of Swei differs from the polysiloxane of the presently claimed invention.

Responsive to such grounds of rejection, Applicant respectfully submits the following points for the Examiner's consideration.

Swei is directed to a filler consisting of an inorganic core and a layer of a network silicone elastomer that covers the inorganic core and that is *chemically bound* to the core (col. 1, lines 30-33.) The goal is to produce, by means of these covered fillers, a thermoplastic polymer matrix of a composite material the tenaciousness of which is improved. To this end, a mono-functional polysiloxane with an end portion functional group is transposed with a multifunctional silane in order to produce multifunctional end portion polysiloxane that, during the process of coating, is increasingly netted to an elastomer and bound to the inorganic core (col. 1, lines 39-49.)

The silicon elastomer disclosed in Swei is a cross-linked reaction product of a multifunctionally terminated polysiloxane and the silane cross-linking agent (column 2, lines 42-45.) Suitable reactive functional groups are described in column 2, lines 63-68. These, and all other polysiloxanes described, and claimed, in the Swei reference carry those functional groups. Thus, Swei does not disclose the presently claimed polysiloxane where R is hydrogen, an alkyl and/or a phenyl group.

In contrast, the polysiloxane presently claimed in claim 1 carries no reactive functional group. The polysiloxane of the presently claimed invention is added to the grain surface and dried. Again, no chemical reaction or any polymerization occurs, nor is the polysiloxane chemically bound to the hard material. In contrast to the teachings of Swei, and due to their excellent creeping qualities, the presently claimed polysiloxanes adjust to micro edges, fissures, creases, and step-like shiftings of the hard grain so that low-viscous liquids may not infiltrate into the grid and so that no diffuse light dispersion will occur at edges and creases. A hard material grain as claimed has a creeping property that is exceptionally suited to preventing transparent layer wearout. The Swei filler, however, which forms a rubber-like shroud that is rigidly bound to the surface, is obviously unsuitable for such a purpose.

Swei fails to teach or suggest explicitly or inherently the presently claimed invention recited in claims 1, 3, 4, 8, 10 and 11, as amended. Thus, and in consideration of the removal of


all grounds for claim rejections, it is therefore submitted these claims are allowable, and notice thereof is earnestly solicited.

If any questions remain, please call Applicant's attorney, collect, at the number given above. If any sums are owed due to claim adjustments, please debit or credit Deposit Account 03-2410, order 12707-P03.

Respectfully submitted,  
DANIELE CASALINI, Applicant

Dated: January 18, 2005

By:

  
John A. Hamilton  
Reg. No. 48,946  
Attorney for Applicant